

MATHIES

REMARKS

Claims 1-3, 6, 9, 13, and 36-40 are pending in the present application. Claims 1 and 9 have been amended, claims 36-40 have been added, and claims 4, 5, 7, 8, 14, and 15-35 have been canceled without prejudice or disclaimer.

In a final Office Action dated August 29, 2000, the Examiner rejected claims 1-13 and 31-35 and allowed claim 14.

In an Amendment and Response filed pursuant to 37 C.F.R. § 1.116(b) on December 28, 2000, Applicant amended the claims as advised in a telephonic interview with the Examiner on November 28, 2000. In the telephonic interview, the Examiner identified allowable subject matter and suggested amendments to the claims that would bring the claims into condition for allowance. Applicant further presented arguments as to why Claims 1-3, 6, 9 and 13 distinguish over the art cited by the Examiner and added new claims 36-40 in accordance with the Examiner's suggestions.

In an Advisory Action dated January 9, 2001, the Examiner advised that, "the limitations of new claims 37-39 are previously unclaimed features requiring further consideration and/or search. Additionally, the limitations of claims 1 and 37-39 are not disclosed within the specification where alleged raising the question of new matter." Thus, Claims 1-3, 6, 9-14, and 31-35 stood rejected. The Examiner also maintained that Claim 1 does not disclose a system which incorporates "two capillaries per container" since "at least one capillary" is required.

Pursuant to the Examiner's suggestions, Claim 1 has been amended to incorporate multiple capillaries and include the limitations of previously allowable claim 14.

MATHIES

In a January 22, 2001 telephonic interview, the Examiner stated that the limitations in claims 37-39, which were not entered, would need to be further specified to include reservoirs within the containers in order to make for patentable subject matter. Applicant has added new Claims 37-39 in accordance with the Examiner's suggestions.

This preliminary amendment is filed concurrently with a request for CPA under 37 C.F.R. § 1.53(d). The request for CPA is being filed to incorporate the suggestions of the Examiner's Advisory Action mailed January 9, 2001 and a subsequent telephonic interview with the Examiner on January 22, 2001.

The Applicant again notes with appreciation the Examiner's allowance of claim 14. In the August 29, 2000 Office Action and again in the November 28, 2000 telephonic interview, the Examiner stated that claim 14 contained patentable subject matter in light of WO 97/34138 to Wilson et al. ("the Wilson reference"). The Applicant has incorporated the patentable subject matter of claim 14, as identified by the Examiner, into independent claim 1 as well as new independent claims 37 and 40. Because the Examiner has stated that claim 14 is allowable, and because claims 1, 37 and 40 incorporate the limitations of claim 14, the Applicant respectfully submits that claims 1, 37 and 40, as amended, are allowable.

The Examiner rejected claim 9 as being indefinite under 35 U.S.C. § 112, second paragraph. The Applicant has amended claim 9 to more particularly point out and distinctly claim what the Applicant regards as its invention. Specifically, the Applicant has removed the limitation "other chemically nonreactive materials" from the claim. The Applicant respectfully submits that claim 9, as amended, comports with the requirements of § 112, second paragraph.

The Examiner rejected dependent claims 2, 3, 6, and 9-13 as unpatentable in view of Wilson. Dependent claims 2, 3, 6, and 9-13 depend directly or indirectly from independent

MATHIES

Claim 1 and thus incorporate all of its limitations. The Applicant has added claim 36, which incorporates limitations of allowed (and now canceled) claim 14 and depends directly from Claim 1. The Applicant respectfully submits that because claim 1 is patentable over Wilson and is allowable, the claims that depend on it – claims 2, 3, 6, 9-13, and 36 – are allowable, as well.

The Examiner suggested that the liquid-handling system of claim 1 would be patentable over Wilson if the system were to incorporate two capillaries per reservoir for the simultaneous removal and loading of liquid. Such a two-capillary system is shown in Figure 7 of the present application and discussed at, for example, page 11, lines 14-21 of the specification. New claims 37 and 40 are directed to a liquid handling system for the removal and loading of liquids from a container configured to include a plurality of wells, the system comprising a first container, a housing encasing the first container in a pressure tight manner, a first capillary tube having a proximal end and a distal end, wherein the proximal end is positioned near the bottom of a first reservoir, the distal end is positioned near the bottom of a second reservoir, and the tube extends through the housing; a second capillary tube having a proximal end and a distal end, wherein the proximal end is positioned near the bottom of the first reservoir, the distal end is positioned near the bottom of the second reservoir, and the tube extends through the housing; a computer-controlled pressure altering device, attached to the housing in a pressure tight manner, that changes the pressure within the housing relative to the pressure outside the housing; wherein the pressure-altering device applies a pressure differential that deposits and removes liquids in the container in either direction through the capillary tubes.

New claims 37-40 merely recite subject matter that the Examiner has suggested would be patentable over Wilson. Wilson does not teach, disclose, or suggest a system wherein two or more capillaries can be used in an individual reservoir to deliver or remove a liquid. Rather,

MATHIES

Wilson discloses a system wherein bi-directional flow is possible between two reservoirs within a single capillary (Wilson, page 6, lines 16-23). It would not be feasible to combine multiple capillaries in a single well in the Wilson system; the capillary receiving sleeves are secured to the capillary array holder in an apparatus, wherein only a single capillary is contemplated for insertion into any particular destination well (Wilson, page 11, line 31 – page 12, line 16).

Wilson therefore does not teach, disclose, or suggest the liquid handling system of new claim 37.

The Applicant respectfully submits that claim 37 is therefore in condition for allowance.

New claims 38 and 39 depend directly from claim 37 and thus incorporate all of its limitations. Because claim 37 should be in condition for allowance, the Applicant respectfully submits that claims 38 and 39 are in condition for allowance, as well.

MATHIES

CONCLUSION

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Entry of the amendment, and reexamination and reconsideration of the application, as amended, are respectfully requested, as is allowance of all claims at an early date.

Applicant's attorney respectfully requests an interview with the Examiner handling the present patent application in the event that this case is not now considered to be entirely in condition for allowance.

If it should be determined, for any reason, that an insufficient fee has been paid, please charge any insufficiency to ensure consideration and allowance of this amendment to the present application to Deposit Account No. 03-3975.

Respectfully submitted,

PILLSBURY MADISON & SUTRO LLP

Date: February 28, 2001

By: 

Richard H. Zaitlen
Registration No. 27,248
Attorney for Applicant(s)
725 South Figueroa Street
Suite 2800
Los Angeles, CA 90017-5406
Telephone: (213) 488-7100
Facsimile: (213) 629-1033